

REMARKS

Claims 1-17 have been examined. With this amendment, Applicants cancel claim 2 and add claims 18-26. Claims 1 and 3-28 are all the claims pending in the application.

I. Claim Rejections

1) The Examiner has rejected claims 1 and 15-17 under 35 U.S.C. § 102(a) as being anticipated by Hiyama *et al.* (US 5,361,203) [“Hiyama”].

2) The Examiner has rejected claims 2-7, 11, 12 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Hiyama in view of Yoshida *et al.* (US 6,690,417) [“Yoshida”].

For at least the following reasons, Applicants traverse the rejections.

Claim 1, as amended, recites an image storage and display system where a “storage control means is capable of changing a compression ratio of said irreversible compressed image data.” The Examiner concedes that Hiyama does not disclose this feature but applies Yoshida to allegedly cure the deficiency. The Examiner contends that one skilled in the art would have combined the references in order “to control the amount of image data to be stored in the memory.” Office Action at page 4.

Yoshida discloses a system where, if the memory designated for storage is insufficient to hold the image data at the requested image resolution, the system changes the compression ratio to a higher compression (lower resolution image) (see at least Abstract, col. 3, lines 40-50 and col. 22, lines 18-61).

Applicants submit that irreversibly compressing images at higher compression ratios would inherently result in a loss of image data. Because the system in Yoshida only looks at

available space, Yoshida does not consider the data loss when varying the compression ratio. Although such a loss may not be critical for the digital camera/telephone disclosed in Yoshida, the loss of image data would be very critical for the medical endoscope images of Hiyama.

Applicants submit that adding such a feature to Hiyama may be detrimental since it may create an image with too much data loss. Accordingly, one skilled in the art would not have combined the teachings as suggested by the Examiner.

In addition, Hiyama specifically discloses the creation of a reversibly compressed image and an irreversibly compressed image (col. 5, lines 21-23). The fact that image data is irreversibly compressed suggests that Hiyama already contemplates saving storage space. However, there is no disclosure or suggestion in Hiyama that multiple irreversibly compressed images at various compression ratios are created for use in different types of analyses.

Accordingly, Applicants submit that Hiyama only contemplates creating one irreversibly compressed image for any analysis required by its system, and the compression ratio of the irreversibly compressed image would already have been optimized for space storage. Accordingly, varying the compression ratio would not provide an advantage to the system of Hiyama.

To the extent the Examiner may be contending that irreversible images with less data loss could be created, Applicants submit that Hiyama contemplates the storage of reversibly compressed images to recapture any data that may be needed. Therefore, storing an irreversibly compressed image with less data loss (higher resolution) than the one already disclosed in Hiyama would actually increase the storage requirements of the system in Hiyama.

Mere, “identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention.” *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). “[T]here must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.” *Id.* Here, there is no motivation or suggestion in the teachings of Hiyama or Yoshida to provide a compression ratio that is variable to the data critical images of Hiyama.

Accordingly, Applicants submit that the Examiner has failed to make a *prima facie* case of obviousness.

Because claims 3, 4, 6, 7, 11 and 15-17 depend on claim 1, Applicants submit that these claims are patentable at least by virtue of their dependency.

In addition, claim 3 recites a “storage control means [that] assigns to each version a parameter or parameters representing an image quality and/or image usage purpose represented by said each version of image data, ... [an] input means [that] is capable of receiving specification of the version of image data as the image quality and/or image usage purpose represented by each version of said image data, and ... [an] acquisition means [that] acquires the version of image data corresponding to the desired image quality and/or image usage purpose received in the input means.” The Examiner contends that Fig. 8 and col. 5, lines 13-17 and lines 23-26 disclose these features.

The cited sections merely disclose that patient data is added together with the endoscope images. There is no disclose or suggestion of acquiring the version of image data by the image recording control device 72 (the alleged acquisition means) corresponding to the information

(desired image quality and/or image usage purpose) received in the image data ID device 62 (the alleged input means). Accordingly, Hiyama does not disclose or suggest at least the claimed acquiring the version of image data corresponding to the desired image quality and/or image usage purpose received in the input means, as set forth in claim 3.

Further, as best understood, the Examiner contends that “patent data” that is added to the endoscope images allegedly corresponds to both the claimed version of the image data and the claimed specification of the version of the image data. As recited, the claimed input means receives a specification of the version of the image data and the claimed acquiring means acquires the version of the image data corresponding to the specification received in the input means. The Examiner’s cited sections merely describes adding patient data to record images. Applicants submit that using the same feature to allege that two different claim elements are disclosed is improper and submit that claim 3 is patentable.

Applicants submit that claim 4 is patentable for analogous reasons.

Because claim 14 recites features similar to that of claim 1 and the Examiner’s rejection of claim 14 is the same as claim 1, Applicants submit that the Examiner has failed to make a *prima facie* rejection of obviousness for at least reasons similar to those given above with respect to claim 1.

Claims 5 recites a “progressively extractable data-compression process.” The Examiner cites Fig. 8 of Hiyama, but does not explain how this figure discloses the claimed combination. Applicants submit that, at most, Hiyama discloses a simple compression/expansion process and not the claimed progressively extractable data-compression process as set forth in claim 5.

In addition, Applicants submit that one skilled in the art would not have combined the teachings of Hiyama and Yoshida for at least the reasons given above with respect to claim 1. Accordingly, claim 5 is patentable.

Applicants submit that claim 12 is patentable at least by virtue of its dependency on claim 5.

II. New Claims

With this amendment, Applicants add claims 18-28. Applicants submit that these claims are patentable at least by virtue of their respective dependencies, as well as the features set forth therein. Applicants note that claims 19-21 depend on claims with allowed subject matter.

III. Allowable Subject Matter

Applicants thank the Examiner for finding allowable subject matter in claims 8-10 and 13 and for indicating that these claims would be allowable if rewritten in independent form.

Applicants have rewritten claims 8-10 in independent form and submit that claims 8-10 are allowable. Applicants hold rewriting claim 13 in abeyance until the subject matter of its base claim is resolved.

IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Amendment Under 37 C.F.R. § 1.111
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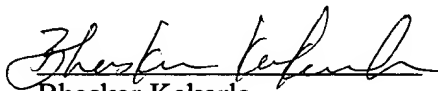
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